

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because Figures 11A to 12 contain improper shading. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a

separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 22-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the instant case the claims are replete with "means for" limitations that are not sufficiently explicit as to exactly what means are being used to achieve the claimed functions.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, independent claim 1 recites, "...understanding personality themes; and action planning and research." It is unclear how these method steps relate to the other cited method steps since the applicant provides no direct link to these steps from the other cited steps.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a claimed process to be considered statutory it must be: (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility; the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity; and the transformation must be central to the purpose of the claimed process. In the instant case there is neither a tie to a particular machine or apparatus, since the recording sheet is not interpreted as a machine or apparatus, and there is no transformation from one thing or state to another.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No: US 2005/0026119 to Ellis et al. (Ellis) in view of US Patent Application Publication No: US 2003/0170597 to Rezek (Rezek).

With Respect To Claims 1-5, 29-31

Ellis discloses a method for an improved career discovery tool comprising the steps of providing a career profile recording sheet and completing the career profile (par. 0015), and action planning (par. 0017, 0020), and assessing values (Table 3) [claim 2], and assessing skills (par. 0014) [claim 3], and assessing career interests (par. 0013) [claim 4].

Ellis, however, fails to specifically teach understanding and assessing personality themes or research.

Rezek discloses a method comprising the steps of understanding and assessing personality themes and research (par. 0026) [claim 5].

**OFFICIAL NOTICE** is taken that it is old and well known in the art of computer systems to use databases and computer processors programmed to store and retrieve information from databases.

It would have been obvious to one possessing ordinary skill in the art, at the time of the invention, to have combined the known teachings of Ellis with those of Rezek by allowing the user of Ellis to use personality themes and research, as taught by Rezek, to yield the predictable result of allowing the user of Ellis to have a plurality of factors to utilize when creating a career profile.

It would have been obvious to one possessing ordinary skill in the art, at the time of the invention, to have used a database and a processor programmed to interface with the database with the modified Ellis invention in order to yield the predictable result of providing electronic storage and access to the information used by the system of Ellis (claims 29-31).

11. Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis and Rezek as applied to claim 1 above, and further in view of US Patent No: US 5,551,880 to Bonnstetter et al. (Bonnstetter).

With Respect To Claims 6-11

Ellis and Rezek teach the limitations of claim 1 (see rejection of claim 1 above), but fail to specifically teach the claimed arrangement of the recording sheet, or the personality themes, or the rankings, as claimed by the applicant.

Bonnstetter discloses a system and method for career assessment wherein a user is allowed to rank and place different hierarchical value statements (col. 7, ll. 62-67 to col. 8, ll. 1-60) [claims 6-7]. Bonnstetter further discloses the assigning of points to categories wherein the user assesses personality themes most or least like themselves (col. 6, ll. 49-67 to col. 7, ll. 1-12) [claim 10].

It is noted that the names given to personality themes is interpreted as non-functional descriptive material which fails to patentably distinguish the claimed invention from the applied prior art since ranking the values is not dependent on the specific name given to the personality theme [claim 6, 11].

It would have been obvious to one possessing ordinary skill in the art, at the time of the invention, to have supplemented the modified Ellis invention with the ability to rank values, as taught by Bonnstetter, in order to provide the user with a profile that would be used for personal and professional development. Furthermore, the ranking of other known attributes such as skills and careers in order to similarly provide profiles for use in personal and professional development are also obvious over the prior art of record [claims 8-9].

12. Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnstetter in view of Ellis, Rezek and US Patent No: US 6,017,219 to Adams et al. (Adams).

With Respect To Claim 22-25

Bonnstetter discloses a computer system within a networked environment for career discovery comprising a memory storage device and a processor operable to store user information and information regarding values, personality themes, career interests (col. 5, ll. 31-34), display prompts to a user, retrieve user inputs in response to the prompts, correlate and score user inputs, determine career assessment results and provide an overall career assessment result based on user inputs, and printing the result (col. 6, ll. 20-36), securely accepting users into the system (col. 19, ll. 49-55). Bonnstetter further discloses a system and method for career assessment wherein a user is allowed to rank and place different hierarchical value statements (col. 7, ll. 62-67

to col. 8, ll. 1-60), and the assigning of points to categories wherein the user assesses personality themes most or least like themselves (col. 6, ll. 49-67 to col. 7, ll. 1-12).

Bonnstetter, however, fails to specifically teach the storing of skills, the direction to a selected database for additional information, or the collection and receipt of user fees, or the specific personality themes and ranking method claimed by the applicant.

The choice to use either the ranking method of Bonnstetter or the one claimed by the applicant is interpreted as a matter of design choice since by using either one or the other the objective of ranking and scoring personality themes with a user is accomplished [claim 23].

See rationale discussed in the rejection of claim 11 above with respect to the rejection of claim 24 [claim 24].

Ellis further teaches the direction of users to additional information (par. 0019), and the storing of skills (par. 0014).

Adams discloses that is old and well known in computing systems to allow for the collection and receipt of user fees by the system (col. 8, ll. 62-67 to col. 9, ll. 1-3).

It would have been obvious to one possessing ordinary skill in the art, at the time of the invention, to have combined the teachings of Bonnstetter, Ellis and Adams by supplementing the invention of Bonnstetter with the ability to store skills in addition to the other information about values and personality themes and careers stored by the system of Bonnstetter, in order to provide the user with a detailed report including requisite skills training required. By allowing this requisite skills assessment to direct the user to other sources for additional information, the user of Bonnstetter would be able to

obtain supplemental or primary information related to identified skill deficiencies.

Furthermore, by also supplementing Bonnstetter with the ability to collect and receive user fees, as is known in the art, and disclosed by Adams, it would allow the system of Bonnstetter to be a profitable business venture.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. US 2004/0058302 to Mayer et al. (Mayer) discloses a system for aiding in career decisions wherein a list of careers is presented to a user, who, uses criterion to rank the careers.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JERRY-DARYL FLETCHER whose telephone number is (571)270-5054. The examiner can normally be reached on Monday to Friday 9:00 a.m. to 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/  
Primary Examiner, Art Unit 3715

/J.D.F./  
Examiner, Art Unit 3715